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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,991	08/18/2003	Daniel Esposito	100.2493	3515
27997	7590	11/21/2005	EXAMINER	
PRIEST & GOLDSTEIN PLLC 5015 SOUTHPARK DRIVE SUITE 230 DURHAM, NC 27713-7736			DESIR, PIERRE LOUIS	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,991

Applicant(s)

ESPOSITO ET AL.

Examiner

Pierre-Louis Desir

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 09/02/2005 have been fully considered but they are not persuasive.

Applicant argues, as related to claims 7 and 10, Yach does not teach that a mobile device uses packet data connection to gain access to calling information commonly accessible to other similar devices, and Yach does not make obvious storing commonly accessible information and delivering the information to a wireless device over a packet data connection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., uses packet data connection to gain access to calling information commonly accessible to other similar devices) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Examiner respectfully disagrees with Applicant's assertions that Yach does not make obvious storing commonly accessible information and delivering the information to a wireless device over a packet data connection, and does not disclose (though this limitation is not recited in the claim language) a mobile device uses packet data connection to gain access to calling information commonly accessible to other similar devices. Yach discloses a device comprises a data component for storing, retrieving, receiving and displaying data including e-

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mail messages, calendar appointments, address information, for launching applications associated with the data, and for connecting to the data packet network for sending and receiving data, and a voice component, connected to the data component for receiving call initiation information, the voice component for initiating and receiving telephone calls, and caller identification information, and for providing the received caller identification information to the data component for cross reference to the data (see paragraph 12). Also, Yach discloses that when wireless connector 125 is configured to reside on a network, wireless connector 125 can monitor the data items 205 for many users across several workstations simultaneously. The data items 205 can originate from Internet sources 135, from other LAN workstations 210 or from external data sources. Data items 205 include: phone calls, e-mail, etc. (see paragraphs 47-48, and 65).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Applicant has amended claim 1 by replacing a data server by a central data server. With this replacement, claim 1 contains subject matter, which was not described in the specification for the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the data server" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Note: for the process of examination, examiner will interpret "the data server" as "the central data server."

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 7-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Yach et al. (Yach), Pub. No. US 2002/0128036.

Regarding claim 1, Yach discloses a wireless communication system for supporting communication by a plurality of wireless devices (see abstract, paragraphs 48, 65, 68), comprising: a packet data interface for supporting packet data communication by each of the plurality of wireless devices (i.e., a dual mode mobile device connected to a data packet network, wherein a data component for connecting to the data packet network for sending receiving data Also see data wireless network item 145) (see figs. 1, 2c, 4, and paragraphs 8 and 12. Also refer to paragraphs 46-47, and page 5, paragraph 48 as related to other users or other wireless devices common access to data); a voice interface for supporting voice communication by each of the plurality of wireless devices (i.e., voice component connected to the data component for initiating and receiving telephone calls. Also see voice wireless network item 150) (see figs. 1, 2c, 4, and paragraphs 8 and 12); and a central data server (desktop workstation or network server item 120) (see figs. 1, 4, 6-10, and paragraph 50) operative to provide data to each of the plurality of wireless device through a packet data connection in order to furnish data to a wireless device upon request by the wireless device (i.e., when a user-defined event has occurred, wireless connector 125 transmits user-selected data items 205 from the computer 120 to mobile device 100. A non exhaustive list of data items that can be sent to mobile device 100 includes e-mail messages, voice-mail indications, calendar events, to do lists, address book entries, work items or other personal information (PIM) data) (see figs. 1, 4, 6-10, and paragraph 38), the central data server providing common access to data by two or more of the wireless devices (i.e., wireless connector 125 operates at computer 120 or at a network server where data items 205 are

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received. When wireless connector 125 is configured to reside on a network, wireless connector 125 can monitor the data items 205 for many users across several workstations simultaneously) (see figs. 1, 4, 6-10, and paragraph 48), the data furnished by the central data server including user accessible data and features (see figs. 1, 4, 6-10, and paragraph 38).

Regarding claim 2, Yach discloses a system (see claim 1 rejection) wherein the central data server is a directory server operative to store a calling directory of parties that may be called, the calling directory storing an identification of each party in association with the telephone number of the party, and to search the calling directory and provide desired calling information to a wireless device upon request by the wireless by the wireless device for calling information (i.e., when a user-defined event has occurred, wireless connector 125 transmits user-selected (i.e., request) data items from the computer to mobile devices. An example of data items that can be sent to mobile devices includes address book entries, or other personal information (PIM) data. This pushed data can be input by the user, or by another, and is typically time sensitive data entered into computer 120 in advance of the even that triggers wireless connector 125, wherein the address book presents the address information associated with the caller identification information, or creates a new address book entry to store information associated with the caller identification information wherein caller identification information includes an originating phone number, and may optionally include a caller name) (see paragraphs 11 and 38).

Regarding claim 3, Yach discloses a system (see claim 2 rejection) wherein the data server is further operative to store a command set for the implementation of calling features available to at least two of the wireless devices and to transfer desired commands to the wireless device when required (i.e., comprising a network server where data items are received

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(paragraph 48) and comprising receiving a voice call containing caller identification information, determining the data component application to launch based on the call preferences and launching the determined data component application. In embodiments of the present aspect of the invention the set of call preferences maps different incoming numbers to different applications, or prompts the user for an application to launch. The applications include at least one of a calendar, call log, address book and email client) (see paragraphs 11 and 48).

Regarding claim 7, Yach discloses a wireless device (i.e., dual-mode mobile device) for communication using directory information and calling features through a packet data connection with a data server (see abstract, and paragraph 11), comprising: a voice connection interface for establishing and maintaining a voice connection for voice communication through a switched voice network (i.e., a voice component, connected to the data component for receiving call initiation information, the voice component for initiating and receiving telephone calls, and caller identification information, and for providing the received caller identification information to the data component for cross reference to the data) (see fig. 2c, and paragraph 12) ; and a business service client module for retrieving from the data server calling information commonly accessible by the wireless device and by other similar wireless devices and for processing and presenting calling information received from the data server (see fig. 2c, and paragraphs 11-12, 38, 48, 68, and 71), the business service client module being operative to direct the initiation of voice communication with a desired telephone upon identification and retrieval of the desired telephone number from the data server (see paragraphs 11-12).

Regarding claim 8, Yach discloses a device (see claim 7 rejection) wherein the business service client module is further operative to retrieve commands from the data server and to

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implement calling features using the commands (i.e., a wireless device (see abstract) comprising a network server where data items are received (paragraph 48) and comprising receiving a voice call containing caller identification information, determining the data component application to launch based on the call preferences and launching the determined data component application. In embodiments of the present aspect of the invention the set of call preferences maps different incoming numbers to different applications, or prompts the user for an application to launch. The applications include at least one of a calendar, call log, address book and email client) (see page 1, paragraphs 11-12).

Regarding claim 9, Yach discloses a device (see claim 8 rejection) further comprising a voice over Internet protocol interface for establishing and maintaining a packet data connection in order to carry on voice communication through the packet data connection (i.e., the voice component can be connected to the data packet network for receiving and initiating telephone calls using Voice over Packet data channels) (see page 2, paragraph 12).

Regarding claim 10, Yach discloses a method of wireless communication, comprising the steps of: establishing a packet data connection between one of a plurality of wireless devices and a directory and features server (i.e., the wireless device comprises a data component for storing, retrieving, receiving and displaying data including e-mail messages, calendar appointments, address information, for launching applications associated with the data, and for connecting to the data packet network for sending and receiving data, and a voice component, connected to the data component for receiving call initiation information, the voice component for initiating and receiving telephone calls, and caller identification information) (see figs. 1, 4, 6-8, and paragraphs 11-12, 38, 48); selecting desired calling information from the server and delivering

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the calling information to the wireless device (i.e., the data component has a preferences table (selection table) that determines an application to launch upon (inherently, this preference table is delivered to the wireless device) receiving caller identification information from the voice component) (see figs. 1, 4, 6-8, and paragraphs 11-12); and initiating and maintaining a call from the requesting wireless device to a telephone identified by the calling information delivered from the server (i.e., the voice component initiates a telephone call upon receiving call initiation information from the data component (see paragraph 12). And, Once the phone number is selected the data handling component of mobile device transmits a request to the cellular phone component to initiate an outbound voice call from the device to the selected phone number. The necessary components of the cellular phone component of the mobile device then initiates and establishes an outbound voice call with the information at least partially collected from the data store) (see paragraph 57).

Regarding claim 11, Yach discloses a method (see claim 10 rejection) wherein the step of selecting the desired calling information further includes presenting a series of selection interfaces to the requesting wireless device (i.e., a menu item such as 'Call Address' is offered as an action among the one or more menu selection action items. An illustrative menu selection is shown in FIG. 2b. As shown, the menu selection 451 graphical user interface (GUI) may include one or more of the following action items: hide menu 452, copy 454, mark unopened 456, file message 458, save message 460, reply 462, forward 464, reply to all 466, delete 468, more 470, email person y 472, SMS person y 474, call person y 476, view contact info 478, show qualified address 480, previous item 482, next item 484, next unopened item 486, close 488) (see fig. 2b,

and paragraphs 11 and 56) and conducting a search in the directory and features server based on user responses to the selection interfaces (see paragraphs 11, 12, 38, and 57).

Regarding claim 12, Yach discloses a method (see claim 11 rejection) wherein the step of establishing the packet data connection is followed by a step of delivering a set of commands to the requesting wireless device to allow access to calling features implemented by the commands (i.e., providing the received caller identification information to the data component for cross reference to the data) (see page 1, paragraph 11; and page 2, paragraph 12).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yach, in view of Hamilton, Pub. No. US 2002/0176377.

Regarding claim 4, Yach discloses a system as described above (see claim 3 rejection).

Although it is known in the art that in a communication system supporting circuit-switched services, RNCs are connected to a mobile switching center of a core network, and the MSC is connected to the gateway mobile switching center managing the access of a voice call requested from or to an external network and Packet-switched services are provided by a serving GPRS support node and a gateway GPRS support node of the core network, Yach does not

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specifically disclose a system wherein the voice interface includes a mobile switching center to support switched voice communication by the wireless devices.

However, Hamilton discloses a system wherein voice interfaces include a mobile switching center to support switched voice communication by the wireless device (see paragraph 66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as described by Hamilton with the teachings as described by Yach to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper functioning of the voice module.

Regarding claim 5, Yach discloses a system (see claim 4 rejection) wherein the voice interface further includes a voice over Internet protocol interface to support voice communication by the wireless device over a packet data connection (see paragraphs 10, 12, and 48).

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yach and Hamilton, in further view of Zhang et al. (Zhang), U.S. Patent No. 6661485.

Yach and Hamilton disclose a system as described above (see claim 5 rejection).

Although the combination discloses a system wherein the data server is further operative to initiate a first call to a telephone number identified in the calling information provided to the wireless device (see paragraph 12), the combination does not specifically disclose a system wherein the data server is further operative to initiate a second call to the wireless device, and to

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bridge together the first and second calls to establish a connection between the wireless device and the identified telephone number.

However Zhang discloses a system wherein a PSTN call is placed to a subscriber whose line is being used for Internet access, and through the service control point, the subscriber places a call through a gateway to the service node. The service node matches the subscriber call and PSTN call and bridges them together to provide a VOIP connection (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings to arrive at the claimed invention. A motivation for doing so would have been to enable subscribers to place and answer telephone calls during an Internet session without having to disconnect Internet access (see abstract).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre-Louis Desir
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11/04/2005


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SUPERVISORY PATENT EXAMINER